

DOCKET NO: 203391US6



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MARI SAITO, ET AL. : EXAMINER: ABEL, J. N.
SERIAL NO: 09/785,204 :
FILED: FEBRUARY 20, 2001 : GROUP ART UNIT: 2165
FOR: INFORMATION PROCESSING :
APPARATUS AND METHOD AND
PROGRAM STORAGE MEDIUM

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The present Reply Brief is submitted in response to the Examiner's Answer (hereinafter "EA") mailed June 18, 2007, in order to correct an oversight as to omitting mention of the rejection of Claim 18 in section "VI" of the and to point out and respond to numerous errors in the "EA."

Turning first to Section "VI" of the second Supplemental Brief (hereinafter "SSB") filed on October 3, 2005, it omitted mention of the third ground of rejection of Claim 18. The complete Section "VI" treating all outstanding rejections should read as follows:

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The first ground of rejection for review is the rejection of Claims 1-4, 9-11, 14-17, and 19 under 35 U.S.C. § 102(e) as being anticipated by Shafer et al. (U.S. Patent No. 6,094,681, hereinafter Shafer). The second ground of rejection for review is the rejection of

Claims 5-8, 12, 13, and 20 as being unpatentable over Shafer in view of Conley, Jr. et al.

(U.S. Patent No. 6,434,745, hereinafter Conley, Jr.). The third ground of rejection for review

is the rejection of Claim 18 as being unpatentable over Shafer in view of Cappi (U.S.

Published Patent Application No. 2002/0038308).

REPLY ARGUMENT

1. Claim 1 is not anticipated by Shaffer

As noted on pages 7-9 of the second Supplemental Brief (hereinafter "SSB") filed on October 3, 2005, Shaffer simply discloses a method and system for automatically providing remote notification of an ongoing event that includes detecting the event by receiving **presently occurring** data and analyzing the content **of this presently occurring** data using a data filter of a computer.

The "EA" first repeats the rejections and the rationale offered in the new Action (hereinafter "NA") mailed July 29, 2004, in item 9 that spans pages 3-15. Page 15 of the EA responds to the points raised in the SSB as to the rejection of Claim 1 at pages 15 to 16 thereof by asserting conclusions as to teachings to be found in Shafer that cannot be found there and by ignoring all the words found in Claim 1 and the duty imposed on the PTO to properly construe claim language.

Turning first to claim analysis required by *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997), it is clear that the court requires that "means" limitations receive special attention as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed "receiving means," nor did the [PTO] expressly find that the "receiving means" disclosed in the specification was structurally equivalent to that embodied in [the reference]. Moreover, the [PTO] also failed to define the exact function of the receiving means, as well as to find that [the reference] disclosed the identical function. (Emphasis added, citation omitted.)

Here, the PTO never has construed the scope of all of the Claim 1 “means” in terms of the “acquisition means,” the “event occurrence detection means,” the “search means,” and the “display control means.” The PTO has also failed to find that this “acquisition means” this “event occurrence detection means,” this “search means,” and this “display control means,” all as disclosed in the specification, are structurally equivalent to what is disclosed by Shafer respectively at the relied upon locations (col. 2, lines 7-23; col. 2, lines 24-37; col. 2, lines 38-59; and col. 2, lines 60-67 with col. 3, lines 1-11). The PTO has also failed to consider the exact functions recited by Claim 1 for these “means” and has failed to demonstrate how Shaffer can be said to disclose the identical function.

Moreover, the PTO has further erred in not separately construing the language of the Claim 1 required “displaying associated information corresponding to a present event,” much less has the EA explained how the “data filter” of col. 2, lines 11-14, of Shafer can be said to acquire “said associated information using **EXISTING INFORMATION CORRESPONDING TO A PAST EVENT**” (emphasis added). This failure to address all the language in Claim 1 is similar to the situation in *Gechter, supra* where the PTO failed to construe the language “agent status messages” before improperly concluding that the reference disclosed this limitation. Here, determining the reasonable meaning of the language “said associated information” must take the recital in the preamble that the claimed information processing apparatus displays this “associated information corresponding to a present event” into consideration.

Pages 15 and 16 of the EA do not properly construe any of the above-noted Claim 1 language and the teachings of Shafer relative to the actual limitations of Claim 1.

The first error in this regard is that Claim 1 does not recite “collection information corresponding (related) to past events” as asserted here. Instead, Claim 1 first recites that the claimed information processing apparatus displays “associated information corresponding to

a present event” and then requires that there be an “acquisition means for acquiring said associated information [“corresponding to a present event”] using existing information [not collection information] corresponding to a past event” (emphasis added). While this “existing information” can be in storage, nothing in the teachings of Shafer points to the data filter 16 using any stored information “corresponding to a past event” to perform its disclosed function of parsing “through data received via the Internet and the Remote LAN 54 to determine whether a predetermined event is included in the received data,” as disclosed at col. 3, lines 47-50.” Nothing is “embodied” in this teaching or the stock price falling below \$50 per share example of col. 2, lines 43-49 and col. 4, lines 21-30, as to any “knowledge of previous information monitored.”

If the same stock was previously monitored for falling below some other price, this is of no moment to the Shafer system that only monitors the update price. Also, the Shafer monitored stock can be a new stock that steadily increased in value to a price above \$50 per share so that it has never previously fallen from a value higher than the monitored value of \$50 to less than this value. Accordingly simply keeping a stock value of \$50 as the value to monitor in no way implies that this \$50 value is “existing information” that reasonably can be said to correspond to any “past event.” Col. 4, lines 20-30 only teach monitoring a price threshold of \$50 per share to indicate if the stock falls below this price threshold, not that this price threshold relates to any “past event.” Even if Shafer actually taught that the \$50 price threshold was stored in a memory and then compared to extracted stock prices, which is not the case, this would not teach that the price of the stock ever previously dropped from a higher price to below \$50 per share. The PTO must point to actual reference teachings not presumptions. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may

not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”)

The EA (at page 15) also notes Shaffer at col. 6, lines 60-66 that simply teach that when “a first predetermined event is not detected, in step 66 the data filter 16 determines if any other events are of concern” and only if there is a second event does the data filter return to step 62 to analyze the data to determine if it includes this second event. Nothing is taught as to any relationship between these events, much less that the previous occurrence of the first event was in any way stored to be analyzed when the independent second event was detected by the data filter.

While Shaffer is concerned with monitoring presently occurring events as noted at the top of page 16 of the EA as to col. 5, lines 2-8 and col. 6, lines 65-66, this is not the subject matter of Claim 1 as the PTO misconstrues it.

2. The subject matter of Claim 9 is not anticipated by Shaffer

As noted on pages 7-9 of the second Supplemental Brief (hereinafter “SSB”) filed on October 3, 2005, there was no explanation of how Shaffer was being interpreted to teach the Claim 9 recited “information processing apparatus for displaying a character on a display device and for displaying associated information related to a **text file processed by a predetermined application program**” (emphasis added) in the NA.

Page 16 of the EA belatedly suggests that col. 6, lines 40-49 disclose an “electronic mail application or browser.” However, the disclosure at col. 6, lines 40-49 indicate the browser 19 of computer 10 simply transmits data, even e-mail messages, to the data filter 16 that still is the element that detects the “event.” There is no disclosed relationship of any display of “associated information related to a **text file processed by a predetermined application program**” as required by Claim 9. The only thing taught at col., lines 54-61 is

the text message to be sent if the filter 16 detects the desired event, not how the filter detects events or how browser 19 forwards data to filter 16, much less the above-noted subject matter of Claim 9. While col. 5, lines 51-54 at least suggest the configuring of the filter to analyze text, this is still a far cry from teaching the above-noted subject matter of Claim 9.

The rebuttal at page 16 of the EA as to “keywords being detected from messages” again misses the point of the SSB arguments that point out that Claim 9 requires that the “key word detection means” must detect “a key word **from said text file processed by said predetermined application program**” (emphasis added). Once again these specific words of Claim 9 appear to be ignored because col. 3, lines 50-53 and col. 5, lines 51-54 teach no such detection of “a key word **from said text file processed by said predetermined application program**” (emphasis added).

3. The subject matter of Claims 15 and 16 is not anticipated by Shaffer

As noted in the SSB, Claim 15 is an independent method claim including steps that closely parallel the limitations of Claim 9 and independent program storage medium Claim 16 is a claim with steps of a computer program that closely parallel the limitations of Claim 9. Thus, these claims recite essentially the same introductory limitation as that of claim 9 requiring “displaying associated information related to a **text file processed by a predetermined application program**” (emphasis added). Once again, col. 5 lines 42-59 may suggest that it would be desirable to extract key words from a message, but this suggestion falls far short of a teaching of the step of Claims 15 and 16 requiring “detecting a key word from said text file processed by said predetermined application program corresponding to said event detected in the processing detecting step.”

Also, col. 3, lines 60-62 argued at page 17 of the EA relate to generating a message to indicate that the event has been detected by data filter 16, not how data filter 16 will detect an

event. The distinction between these entirely different activities (detecting keywords and generating messages after such detection) would be understood by the artisan contrary to the subjective conclusion offered at page 17 of the EA.

4. The subject matter of Claim 11 is not anticipated by Shaffer

As also noted in the EA, Claim 11 depends on Claim 9 and defines over Shaffer for the same reasons Claim 9 does and because it further requires “output means for outputting a voice signal corresponding to said text information displayed by said display control means” (emphasis added).

Page 17 of the EA suggests that a “[v]oice signal is a beep noise or any indicator of received message (i.e. text information).” The editors of English language dictionaries will surely be surprised with the new PTO definition of “voice.”

5. The subject matter of Claims 7 and 8 is not obvious over Shaffer in view of Conley, Jr.

As noted in the SSB, independent Claims 7 and 8 both include steps that closely parallel the limitations of Claim 9. Thus, these claims recite essentially the same subject matter as Claim 9 in terms of a text file (“selecting an important word from among words contained in said existing text file”). Once again these specific “text file” limitations are swept away by simply asserting that they are given a broadest reasonable interpretation and found to exist in the suggestion of concentrating on e-mail messages or calendar messages mentioned at col. 6, lines 1-6 as the event. See the top of page 18 of the EA.

However, nothing in the suggestion of somehow analyzing an e-mail message or a calendar reminder from 13 teaches “selecting an important word from among words contained in said existing text file” (emphasis added). Moreover, the later step of these claims requiring “detecting a keyword from said text file corresponding to said event detected

in the event occurrence detecting step" has nothing to do with anything reasonably taught at col. 3, lines 48-64 of Shaffer that only teach generating a text message as a notification, not as a text file for any key word selection.

7. Dependent Claims 2-4, 10, and 17-19

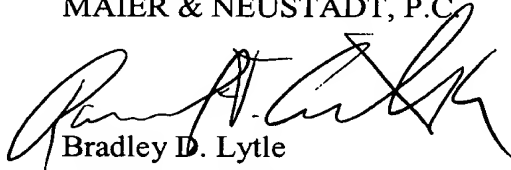
While no specific arguments directed to the rejections applied to dependent Claims 2-4, 10, and 17-19 have been presented, this simply means that such dependent claims will stand or fall with their associated independent Claim.

CONCLUSION

The rejections applied to Claims 1-20 should all be reversed as being clearly improper under the controlling precedent cited in the SSB and above and for the reasons noted in the SSB and further explained above.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

BDL:RFC:jmp

Raymond F. Cardillo, Jr.
Registration No. 40,440